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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/727,953 | 11/30/2000 | Guy McIlroy | PALM-3281.US.P | 5875 |
| 49637 | 7590 | 05/17/2005 | EXAMINER | |
| BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069 | | | KHOSHNOODI, NADIA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2133 | |

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,953

Applicant(s)

MCILROY, GUY

Examiner

Nadia Khoshnoodi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 22-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's arguments/ amendments with respect to amended claims 1, 8, 10, & 16-18 and previously presented claims 2-7, 9, 11-15, and 19-21 filed December 23, 2004 have been fully considered but are not persuasive. The Examiner would like to point out that this action is made final (See MPEP 706.07a).

Applicant contends that Benson fails to teach or suggest the claimed limitation "validating said software...denying said software the ability to access said computer system if said validator fails to identify said software as valid in order to ensure the security of said computer system." Examiner respectfully disagrees. Benson teaches a smart card storing a public/private key which must be supplied by software on the customer's behalf in order to request access to the computer system's resources, i.e. rental software (col. 7, lines 15-17). Furthermore, once the smart card is input into a system, the software enables the smart card information to be transmitted and utilized for authentication/validation purposes in order for the system with the rental software to allow/deny access to the system (col. 13, line 50 – col. 14, line 24). The smart card provides security by having asymmetric cryptography capabilities, including executing digital signatures (col. 8, lines 11-16). The digital signature in the smart card is used in order for the system to validate or disallow usage of the rental software, hence marking the smart card software as valid or invalid to use (col. 8, lines 50-64). Also, the smart card is used by the validator program in order to validate that the smart card being used is in fact valid for what is being accessed (col. 9, line 37 – col. 10, line 3). If at any point in time the digital signature or counter on the smart card yield results that show the access to the rental software

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should be stopped, the system then denies the smart card the ability to further access the computer software, i.e. the rental software in that system (col. 8, lines 65-67 and col. 9, lines 37-66). Finally, Benson also teaches that the smart card assists the computer system in ultimately ensuring its security (col. 6, lines 66-67).

Furthermore, Applicant suggests that claims 8 and 18 distinguish over Benson for similar reasons as recited in regards to claim 1. Examiner respectfully disagrees based on the reasons stated above in regards to why claim 1 does not distinguish over Benson. Furthermore, more specific to claims 8 and 18, Ellison et al. teach that a hand-held or a portable computing device, i.e. a laptop can also be used as the platform (col. 2, lines 1-9).

Regarding claim 4, which recites "the method described in claim 1 wherein said software is supplied by a third-party source," Benson also teaches that a Certificate Authority is useful in binding a user to a public/private key pair and storing those credentials in a smart card (col. 3, lines 11-48). Furthermore, Benson also teaches that a customer obtains the smart card from another party (col. 13, lines 45-46).

Finally, regarding claim 6, which recites, "the method described in claim 1 wherein said validator program is specially constructed to reside in a secure fashion in said computer system," Benson further teaches that the results of the validator program are written to an audit file which must be kept secure because it would otherwise be susceptible to an attacker corrupting, deleting, or abusing the audit trail (col. 7, line 47 – col. 8, line 10 and col.9, line 1 – col. 10, line 3).

Due to the reasons stated above, the Examiner maintains rejections with respect to amended claims 1, 8, 10, & 16-18 and previously submitted claims 2-7, 9, 11-15, & 19-21. Benson teaches the limitations that the Applicant suggests distinguish from the prior art.

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Furthermore, Ellison et al. in combination with Benson teach the limitations not explicitly disclosed by Benson. Therefore, it is the Examiner's conclusion that amended claims 1, 8, 10, & 16-18 and previously submitted claims 2-7, 9, 11-15, & 19-21 are not patentably distinct or non-obvious over the prior art of record as presented.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson, United States Patent No. 6,334,118 and further in view of Ellison et al., United States Patent No. 6,760,441.

See Previous Office Action (Mail Date 8/25/2004).

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825. The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Nadia Khoshnoodi
Nadia Khoshnoodi
Examiner
Art Unit 2133
5/6/2005

NK

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